

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT H. MONTGOMERY, JR.

Appeal 2006-3018
Application 10/657,397
Technology Center: 1700

Decided: September 28, 2006

Before WARREN, WALTZ, and JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the Examiner finally rejecting claims 22 through 25, all of the claims in the application.

Claim 22 illustrates Appellant's invention of a protective wear sleeve for a bit holder, and is representative of the claims on appeal:

22. A protective wear sleeve for a bit holder of a cutting tool assembly wherein the bit holder contains a central bore, and the wear sleeve comprises:

an elongated body having an axial forward end and an axial rearward end;

the elongated body having a solid enlarged diameter portion adjacent to the axial forward end thereof and a split portion beginning at and extending in an axial forward direction from the rearward end wherein the split portion contains a slot so that the split portion is flexible in a radial direction, and a solid intermediate portion being between and contiguous with the enlarged diameter portion and the split portion;

the split portion having an external surface that is uniform over the entire length thereof, and the intermediate portion having an external surface that is uniform wherein the diameter of the external surface of the split portion is equal to the diameter of the surface of the intermediate portion; and

when the wear sleeve is in the central bore, the external surface of the split portion is biased in a radial outward direction against the central bore of the bit holder so as to retain the wear sleeve in the central bore of the bit holder.

The reference relied on by the Examiner is:

Peterson	US 5,683,143	Nov. 4, 1997
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The Examiner has rejected appealed claims 22 through 25 under 35 U.S.C. § 102(b) as being anticipated by Peterson (Answer 3-4).

We reverse.

We refer to the Answer and to the Brief and Reply Brief for a complete exposition of the positions advanced by the Examiner and Appellant.

OPINION

We agree with Appellant's position set forth in the Brief and Reply Brief, and add the following thereto for emphasis.

The issues in this appeal involve the "split portion" of the claimed wear sleeve encompassed by claim 1. The "split portion" portion has the

following limitation in terms of structure: “wherein the split portion contains a slot so that the split portion is flexible in a radial direction.” We determine that this limitation further requires that the material in this portion must be capable of being “flexible in a radial direction,” and indeed, the specification discloses to one skilled in the art that this portion can be made of “spring like resilient material” (specification 7:8-18). This structure and material is further limited by the clause “when the wear sleeve is in the central bore, the external surface of the split portion is biased in a radial outward direction against the central bore of the bit holder so as to retain the wear sleeve in the central bore of the bit holder.” Thus, the material of the split portion must be capable of being “flexible in a radial direction” and “biased in a radial outward direction.”

Appellant correctly points out in the Reply Brief that Peterson does not disclose to one skilled in this art, either expressly or inherently, that as a matter of fact the portion of sleeve **35** having slots **51** for roll pin **49** is made of material that provides the claimed characteristics of the material in the split portion of the wear sleeve in claim 1 (Peterson col. 3, l. 65, to col. 4, l. 41, and **FIG. 4**). These claim requirements are not addressed by mere structure alone.

Accordingly, in the absence of a prima facie case of anticipation which addresses all of the claim limitations, we reverse the ground of rejection of appealed claims 22 through 25 under 35 U.S.C. § 102(b).

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The Examiner's decision is reversed.

REVERSED

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